D-1077+15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:)	
Jay Paul Drummond, et al.)	
)	Art Unit 3624
Serial No.: **09/578,291**)	
)	
Confirm. No.: **5931**)	
)	
Filed: **May 25, 2000**)	Patent Examiner
)	**Kelly Scaggs Campen**
For: **Automated Banking Machine**)	
System With Multiple Entity)	
Interface)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning

the above-referenced Application. The Reply Brief is in response to the Examiner's Answer

("Answer") dated April 21, 2006.

STATUS OF CLAIMS

Claims 1-32 are pending in the Application.

Claims rejected:	1-32
Claims allowed:	none
Claims confirmed:	none
Claims withdrawn:	none
Claims objected to:	none
Claims canceled:	none

Appellants appeal the rejections of claims 1-32. These claim rejections were the only claim rejections present in the Office Action ("Action") dated July 15, 2005, which was made non-final and which had reopened prosecution in view of Appellants' first Appeal Brief filed February 3, 2005. Claims 1-32 have been rejected at least twice.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds to be reviewed in this appeal are:

Whether Appellants' claims 1-32 are anticipated under 35 U.S.C. § 102(b) by the Los Angeles Times article, "TRADE IT YOURSELF BANK MACHINES MAKE A DEBUT" ("LA Times");

Whether Appellants' claims 1-32 are unpatentable under 35 U.S.C. § 103(a) over LA Times; and

Whether Appellants' claims 1-32 are unpatentable under 35 U.S.C. § 103(a) over LA Times in view of Infoworld article, "TP-Monitor Vendors Spin Web features" ("Infoworld") or Anderson, et al., U.S. Patent No. 5,706,442 ("Anderson").

ARGUMENT

The Answer includes a "Grounds of Rejection" section beginning on page 3. All of the grounds of rejection included in this section of the Answer are substantially identical to those previously presented in the Office Action dated July 15, 2005. Appellants' Supplemental Appeal Brief filed on October 11, 2005 is incorporated herein by reference.

Appellants respectfully submit that the rejections have been addressed in Appellants' Appeal Brief, and Appellants have shown that all rejections should be reversed. Therefore please refer to Appellants' previous arguments in the Appeal Brief regarding all the issues of record.

The following arguments specifically reply to assertions made in the Answer. However, even though the present reply has been organized in a manner which addresses issues and arguments as presented in the Answer, Appellants do not waive their right to have all of their claims, each of which was separately argued in the Appeal Brief, considered independently of each other by the Board. If the Board has an unwritten policy which considers the format of the present Reply Brief to be a waiver of Appellants' right to have each separately argued claim in the Appeal Brief be independently considered by the Board, then Appellants respectfully request that the Board so notify Appellants and provide an opportunity for Appellants to submit a revised Reply Brief.

Response to Arguments in Examiner's Answer

Beginning at the bottom of page 7 of the Examiner's Answer, there is a section labeled "**Response to Arguments**" which presents additional arguments and clarifications in response to Appellants' Appeal Brief. Appellants respectfully submit that these additional arguments do not

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overcome the numerous deficiencies in the rejections pointed out in Appellants' Appeal Brief. The Examiner has again failed to establish that each of the recited elements, features, relationships, and steps pointed out in the Appeal Brief as missing in the applied art, can be found in the prior art. The Examiner has not established anticipation or *prima facie* obviousness based on the applied art. In addition, the Examiner has again failed to establish that the prior art contains any teaching, suggestion, or motivation to combine the features of the cited references as is legally required to sustain the rejections based on obviousness. Therefore it is respectfully submitted that all of the rejections of claims 1-32 should be reversed.

Claims 1-7, 28 and 29

With respect to independent claim 1 and dependent claims 2-7, 28, and 29, the Answer has again failed to show that LA Times, Infoworld and/or Anderson discloses or suggests:

- **determining through operation of an automated banking machine, data corresponding to an entity with which a customer operating the machine has an account; and**

- **providing through an output device on the automated banking machine at least one output uniquely corresponding to the entity with which the customer has the account.**

Nowhere do LA Times, Infoworld or Anderson disclose or suggest, either individually or in combination, these features, relationships and steps specifically recited in claim 1.

In addition, the Examiner's Answer further admits that "*LA Times is silent as the precise nature of the user interface at the Citibank ATM*" (Page 5, lines 20-21). This acknowledgment

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further constitutes an admission by the Examiner that the 35 U.S.C. §102(b) and 35 U.S.C. §103(a) rejections of claims 1-7 and 28-29 over LA Times alone, are not supported by LA Times alone and therefore should be reversed.

To attempt to find the above-recited features acknowledged as missing from the teachings of LA Times, the Answer asserts Infoworld in combination with LA Times as a basis for a 35 U.S.C. §103(a) rejection. Specifically, the Answer points to the sentence fragments *"enable transactions over the web"* and *"to make one or 10,000 machines look as if they are local to your computing resource"* (Page 6, lines 2-3).

Appellants respectfully submit that these sentence fragments read alone, or in view of the reset of Infoworld, LA Times and/or Anderson, still do not disclose or suggest the above-recited features in claim 1. For example, Infoworld is directed to a middleware application entitled "Top End" (Page 1, line 1 of the Abstract). The "computer resource" refers to a resource at a server. Thus the middleware application makes one or 10,000 machines on the Internet appear from the perspective of the server as if they are local machines on a local network. This sentence fragment and indeed the entire Infoworld reference, says nothing about the user interface output at the client machines or at an ATM. Nowhere does Infoworld disclose or suggest providing a customer with an output at an ATM that uniquely corresponds to the entity (for example, a particular bank) that is determined to have the account of the particular customer. Thus Infoworld does not disclose or suggest the recited features in claim 1 pointed out in the Appeal Brief as missing from the applied art.

In the alternative, the Examiner also points to Anderson as part of the 35 U.S.C. §103(a) rejection with LA Times and/or Infoworld. With respect to Anderson, the Answer asserts (at Page 6, lines 7-9) that Anderson discloses a *"system comprising an Internet browser interface,*

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specifically a hypertext mark-up language web browser". However, this is not what is recited in

Appellants' claim. The mere teaching of an Internet browser interface does not establish that the

specifically recited features in claim 1 mentioned above, are known in the prior art. Nowhere

does Anderson disclose or suggest, based on data determined by the ATM, providing a customer

with an output from the ATM that uniquely corresponds to the entity which has the account of

the ATM customer.

Thus, LA Times, Infoworld and Anderson do not explicitly disclose or suggest the above

recited features form claim 1. Nor would these features be inherent.

Anticipation by inherency requires that the Patent Office establish that persons skilled in

the art would recognize that the missing element is necessarily present in the reference. To

establish inherency the Office must prove through citation to prior art that the feature alleged to

be inherent is "necessarily present" in a cited reference. Inherency may not be established based

on probabilities or possibilities. It is plainly improper to reject a claim based merely on the

possibility that a particular prior art disclosure could or might be used or operated in the manner

recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

Each of LA Times, Infoworld, and Anderson may very easily carry out their respective

functions for customers using standardized common user interfaces. There is no inherent

requirement that any of these references provide a customer with an output that uniquely

corresponds to the entity determined by the machine to have an account of the customer. Further,

none of these references discloses or suggests an automated banking machine which carries out

these steps.

The Answer states (at page 9, lines 8-10) that *"one cannot show nonobviousness by*

attacking references individually where the rejections are based on combinations of references".

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Appellants respectfully disagree that this assertion is relevant to the arguments presented in their Appeal Brief.

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Thus an obviousness rejection can be shown to be improper by pointing out that the Office has failed to establish *prima facie* obviousness. This typically includes pointing out that one or more of the features, relationships, and steps that are recited in the claim are not disclosed or suggested in each of the cited references. Appellants in their Appeal Brief and the present Reply Brief have shown that the Office has failed to establish that the above listed features recited in claim 1 are disclosed or suggested in any of the applied references.

On this basis and for the reasons discussed in the Appeal Brief, it is respectfully submitted that all of the rejections of claims 1-7, 28 and 29 should be reversed.

Claims 8-27, and 30-32

With respect to independent claims 8 and 19 and dependent claims 9-18, 20-27, and 30-32, the Answer has again failed to establish where LA Times, Infoworld and/or Anderson discloses or suggests:

<u>From claim 8</u>

- reading card indicia on a card presented by a customer to an automated banking machine, the card indicia including entity data corresponding to an entity with which the customer has an account;

- resolving network address data with the banking machine responsive to the entity data and data stored in a data store;

- operating a browser in the banking machine responsive to the resolved network address data, to access at least one network address in a network;

- the network address accessed corresponds to an address of a server adapted to deliver documents corresponding to the entity with which the customer has the account.

<u>From Claim 19</u>

- wherein the automated banking machine is operative responsive to reading card indicia on a card read by the card reading device, to cause the browser to connect through the network to a network address of an institution server corresponding to the card indicia.

The Answer has failed to show where each of these steps, features, and relationships recited in claim 8 or claim 19 are shown in LA Times, Infoworld, or Anderson. Further, these features would not be inherent in the applied art.

For example, LA Times is an article which discusses Citibank using a "specially designed" ATM to offer brokerage services. Such brokerage services could be carried out through communication with a common Citibank server which stores brokerage information for client accounts. There is no inherent need for the ATMs mentioned in LA Times to resolve a network address with which the ATMs will communicate, from entity data read from card and data stored in a data store. The network address of the Citibank server with which the ATMs communicate to provide the brokerage services could be hard coded in the programming of the Citibank ATMs. Further, LA Times does not disclose or suggest that the Citibank ATMs are even capable of acquiring brokerage information from other entities besides Citibank. Thus, there is no teaching or need in LA Times for an ATM to access a network address resolved from entity data read from a card of a user, as specifically recited in Appellants' claim 8. Similarly, there is no teaching or need in LA Times for an ATM to connect through a network to a network address of one of a plurality of institution servers corresponding to card indicia read from a card, as specifically recited in Appellants' claim 19.

In addition, Infoworld is directed to a middleware application entitled "Top End" (Page 1, line 1 of the Abstract). Top End corresponds to a "transaction processing " monitor. ATMs and cash registers are configured to communicate with the Top End transaction processing monitor through the Internet. However, Infoworld does not disclose or suggest the process that ATMs or cash registers go through to connect to the Top End transaction processing monitor. Such ATMs and cash registers could be hard coded with the network address of the Top End transaction processing monitor. Thus there is no teaching or need for the ATMs or cash registers discussed in Infoworld to ever resolve a network address of a Top End transaction processing monitor, let

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alone resolve such an address from entity data read from a card. Further, Infoworld does not disclose or suggest that ATMs or cash registers in Infoworld would ever need to access different Top End transaction processing monitors associated with different entities or institutions.

Thus there is no teaching, suggestion or need for an ATM as discussed in Infoworld to access a network address resolved from entity data read from a card of an ATM user, so as to be able to connect to that particular network address, as recited in Appellants' claim 8. Similarly, there is no teaching or need for an ATM as discussed in Infoworld to connect through a network to a network address corresponding to card indicia read from a card, as recited in Appellants' claim 19.

In addition, Anderson is directed to a system for delivering financial information. Anderson uses a proprietary "Conductor System" based on distributed system technology (Column 1, lines 56-57). The system works to provide financial information to users through PCs which access the Conductor System through the Internet (Column 2, lines 52-53). As shown in Figure 1 of Anderson, all network packets are routed through a common firewall (20) to a common web server (22) (Column 3, lines 7-10). Further, Anderson specifically teaches that *"clients are completely isolated form back-end data sourcing concerns and do not need to know the IP addresses of severs"* (Column 4, lines 10-13). Thus Anderson specifically teaches away from a need for a banking machine to resolve a network address from entity data read from a card, or for a banking machine to connect to a network address of an institution server corresponding to card indicia read from a card.

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It follows that LA Times, Infoworld, and Anderson do not explicitly disclose nor suggest, nor inherently disclose, all of the features, relationships, and steps recited in Appellants' claims 8 or 19. Therefore the Office has not established *prima facie* obviousness.

Also, a reference (such as Anderson) teaching away from the recited invention cannot support an assertion of obviousness. It is improper to reconstruct the recited invention from the disclosure of the Appellants. An obviousness rejection cannot be based on a combination of features in references, if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988)*.

For these reasons and the reasons discussed in the Appeal Brief, it is respectfully submitted that all of the rejections of claims 8-27, and 30-32 should be reversed.

CONCLUSION

Each of Appellants' pending claims specifically recites elements, features, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for producing the recited invention. For these reasons, it is respectfully submitted that all of the rejections should be reversed.
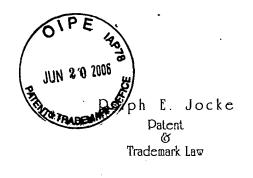
Respectfully submitted,

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June 19, 2006

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Re: **Application Serial No.:**   **09/578,291**
      Appellants: **Jay Paul Drummond, et al.**
      Filing Date: **May 25, 2000**
      Confirmation No.:   **5931**
      Title: **Automated Banking Machine System With Multiple Entity Interface**
      Docket No.:   **D-1077+15**

Sir:

Please find enclosed the Appellants' Reply Brief pursuant to 37 C.F.R. § 41.41 for filing in the above-referenced application.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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